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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,527	07/10/2003	Craig Fellenstein	AUS920030364US1	3550
50170 7590 09/03/2008 IBM CORP. (WIP) c/o WALDER INTELLECTUAL PROPERTY LAW, P.C. 17330 PRESTON ROAD SUITE 100B DALLAS, TX 75252				
EXAMINER JEAN GILLES, JUDE				
ART UNIT 2143		PAPER NUMBER		
MAIL DATE 09/03/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/617,527

**Applicant(s)**

FELLENSTEIN ET AL.

**Examiner**

JUDE J. JEAN GILLES

**Art Unit**

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 12-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in Reply to communication filed on 05/21/2008.

#### ***Response to Arguments***

1. Applicant's arguments, see remarks pages 5-12, filed 05/21/2008, with respect to the rejection(s) of claim(s) 1-33 under Barra et al in view of Patterson have been fully considered and are persuasive with regard to canceled claims 2, 8-11, and 16-33. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made Barra et al in view of Leonard US 6721784 B1. The reason to combine and proper motivation is provided below.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-7, and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Barra et al (hereinafter Barra), Pub. No. 2002/0104026 A1 in view of Leonard.

Regarding claim 20, Barra teaches the invention substantially as claimed. Barra discloses a method for providing electronic mail (e-mail) services (fig. 1), said method

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comprising:

receiving from an original sender a request for tracing notifications, for an e-mail message (0094);

in response to said request, creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications (0094; note that the tag in question can be the "action" taken or the "return receipt" confirming special service such as tracing notification/return receipt services); and

receiving at a computing device of the original sender said tracing notifications from one or more non-original recipients in response to (0095-0096). However Barra does not disclose the details of "said e-mail message forwarded by an original recipient to at least one non-original recipient" and the step of "providing limits for said tracing notifications, wherein said providing limits further comprises one or more limiting actions selected from a group consisting of: limiting the time during which said tracing notifications operate, limiting the number of retransmissions for which said tracing notifications operate, limiting said tracing notifications' operation, based on a domain policy, limiting the content of said tracing notifications, and discontinuing said tracing notifications, in response to a signal from said original sender". Nonetheless, this features are well known and would have been an obvious modification to the system shown by Barra as evidenced by Leonard.

In an analogous art, Leonard teaches a plurality of new recipients receiving forwarded messages not initially intended to them, and notification messages forwarded from

those recipients to senders that may be different from the originator/creator (see Leonard fig. 2; column 10, lines 19-34; column 15, lines 7-22). Note that *a forwarding request from the original recipient is handled in exactly the same manner as a request by the recipient to view the original message, i.e., by notification sent by the central server to the intended recipient of the forwarded message that an electronic mail message has been received.*

Given these features, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system shown by Barra to employ the features of Leonard in order to facilitate forwarding tracing notification from non-intended recipient to the original sender and limiting said tracing notifications based on a number of factors (see Leonard fig. 2). By this rationale claim 1 is rejected.

Regarding claims 3-7, and 12-15, the combination Barra-Leonard discloses:

3. (Original) The method of Claim 1, further comprising:

providing to a user a representation of said e-mail message,

together with information as to who has been provided with the content of said e-mail message (see Barra, 0109).

4. (Original) The method of Claim 3, further comprising:

storing and updating said information (see Barra, 0109).

5. (Original) The method of Claim 1, further comprising:

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transmitting said tracing notifications to said original sender, from said at least one non-original recipient (see Leonard fig. 2; column 10, lines 19-34; column 15, lines 7-22).

6. (Previously presented) The method of Claim 5, wherein said transmitting tracing notifications further comprises transmitting one or more tracing notifications selected from [[the]] a group consisting of:

notifications reporting that said message has been sent somewhere in some manner, notifications reporting that the content of said message was provided to said at least one non-original recipient, and notifications reporting deletion of said message (Barra, 0019, and 0082).

7. (Currently amended) A method for providing e-mail services, said method comprising:

in response to a request from an original sender, transmitting tracing notifications to a computing device of said original sender from one or more non-original recipients in response to (see Barra; 0094-0096); and

when an e-mail message forwarded by an original recipient to at least one non-original recipient (see Patterson, column 5, lines 15-60); and

providing limits for said tracing notifications, wherein said providing limits

further comprises one or more limiting actions selected from a group consisting of:

limiting the time during which said tracing notifications operate.

limiting the number of retransmissions for which said tracing notifications operate, limiting said tracing notifications' operation, based on a domain policy, limiting the content of said tracing notifications, and discontinuing said tracing notifications, in response to a signal from said original sender (see Leonard fig. 2; column 10, lines 19-34; column 15, lines 7-22). The same motivation utilized for the rejection of claim 1 is also valid for this claim. By this rationale, claim 7 is rejected.

12. (Original) The method of Claim 7, wherein said transmitting tracing notifications further comprises:

signaling that the content of said e-mail message has been provided to said at least one non-original recipient (see Barra, 0009, 0024, and 0038).

13. (Original) The method of Claim 7, wherein said transmitting tracing notifications further comprises:

signaling that said e-mail message has been forwarded to said at least one non- original recipient (see Leonard fig. 2; column 10, lines 19-34; column 15, lines 7-22).

14. (Original) The method of Claim 7, further comprising:

providing to a user a representation of said e-mail message, together with information as to who has been provided with the content of said e- mail message (see Barra, 0109).

15. (Original) The method of Claim 14, further comprising:

storing and updating said information (see Barra, 0109).

***Conclusion***

4. ***This action is made Non-Final.*** Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollenger, can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3301.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0800.

/Jude J Jean-Gilles/

Primary Examiner, Art Unit 2143

September 1, 2008